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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,221	10/06/2000	Mark Rupert Tucker	HA01-P01	3673

7590 05/19/2003

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EXAMINER

NASH, BRIAN D

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 05/19/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,221

Applicant(s)

TUCKER, MARK RUPERT

Examiner

Brian D Nash

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22 is/are rejected.
- 7) ☒ Claim(s) 23-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment received 10 April 2003. Examiner acknowledges cancellation of all original claims 1-19 and the addition of new claims 20-39.
2. Claims 23-39 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,769,974 to Davis in view of US 5,656,285 to Sablotsky et al. Davis discloses the invention substantially as claimed including a process having first and second (16,18) feeding strips (see Davis, Fig. 1), heat-sealing the strips together both longitudinally (26,28) and transversely (32,34), introducing a liquid via a tube (30) into a pouch (40); a transverse cutting step (see Davis, column 6, lines 53-55); creating two laterally adjacent pouches (see Davis, column 5, lines 62-63); flushing the pouches with a gas (see Davis, column 12, lines 48-61) via a tube (82,84,86); filling the pouches at a low pressure (see Davis, column 12, lines 15-25); and

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adjusting number or size of the pouches made (see Davis, column 7, lines 48-53). Davis does not disclose a first, multi-layered strip or a cutting cylinder for lateral separation of the pouches.

However, Sablotsky teaches the use of a multi-layered strip having a backing layer, an adhesive layer, and a release liner to form transdermal patches (see Sablotsky, column 3, lines 41-44) and a cutting cylinder (18,22) for the purpose of making transdermal patches in a singular and continuous mechanical motion.

Regarding claim 20, it would have been obvious to one having ordinary skill in the art to have provided Davis's process with a multi-layered strip, as taught by Sablotsky, having a backing layer, an adhesive layer, and a release liner in order to form transdermal patches.

Response to Arguments

5. Applicant's arguments filed 10 April 2003 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that US 4,769,974 to Davis in view of US 5,656,285 to Sablotsky et al does not obviate the claimed invention. Examiner acknowledges applicant's position; however, references in combination are deemed to properly obviate a claim when the prior art teach or suggest all the claim limitations. Regarding claims 20-22 and applicant's remarks the examiner notes that the primary reference of Davis teaches a process for forming, filling, and sealing pouches wherein Sablotsky teaches the use of a multi-layered strip having a backing layer, an adhesive layer, and a release liner to form transdermal patches as described in paragraph 4 of this office action. Furthermore, the term "gel" does not exclude such materials as "food stuffs" and the examiner notes that Davis refers to "food stuffs" as condiment packages wherein the example of a mustard packet can be considered to be a "gel".

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, motivation to combine is present in that the process of making form, filled, and sealed patches is analogous as a manufacturing process.

For the reasons above, the grounds for rejection are deemed proper.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is (703) 305-4959. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at (703) 308-2187.

The fax numbers for this Group are:

Before Final	703-872-9302
After Final	703-872-9303
Customer Service	703-872-9301

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Brian D. Nash
14-May-03



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700